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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,705	03/05/2002	Peter Michalos	J504-005 US	4788

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EXAMINER	
JONES, KENDRA L	
ART UNIT	PAPER NUMBER
4148	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/090,705	MICHALOS ET AL.	
	Examiner	Art Unit	
	Kendra L. Jones	4148	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 March 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *05 March 2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to application no. 10/090705 filed on 03/05/2002.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Crawford et al (4,380,239)** in view of **Katims (US5078714A).**

4. **Regarding claim 1,** Crawford discloses an apparatus for facilitating location of an electrically conductive probe extending through a body passage, using a tool (pg.4, claim 5), but fails to disclose a circuit which is normally open and which includes a signaling mechanism and power source for powering the signaling mechanism to generate a signal that can be perceived by a practitioner when the circuit is closed; and

means for attaching the circuit to conductive portions of the probe and the tool, the circuit being closed when the tool touches the probe to generate the signal.

However, Katims teaches a circuit which is normally open and which includes a signaling mechanism and power source for powering the signaling mechanism to generate a signal that can be perceived by a practitioner when the circuit is closed; and means for attaching the circuit to conductive portions of the probe, the circuit being closed for the probe to generate the signal (See Abstract).

Given the teachings of Katims, it would be obvious to one of ordinary skill in the art at the time of the invention to modify Crawford's invention with the circuit, signaling mechanism, and means for attaching the circuit to conductive portions of the probe and the tool. Doing so would facilitate an improved way to guide a probe through a comprised area for treatment.

5. **Regarding claim 2**, Crawford fails to disclose an apparatus, wherein the signaling mechanism generates at least one of an audible and a visual signal.

However, Katims teaches an apparatus, wherein the signaling mechanism generates at least one of an audible and a visual signal (col. 7, lines 8-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a signaling mechanism that generates an audible or visual signal as disclosed in Katims in the modification of an apparatus for facilitating location of an electrically conductive probe extending through a body passage, using a tool, to achieve the claimed invention.

The motivation for the combination would be to provide means for locating the probe through non-obtrusive means.

6. Claims 3,4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Crawford et al (4,380,239)** in view of **Katims (US5078714A),** as applied to the claims above, and further in view of **Hook (US1668847A).**

7. **Regarding claim 3,** Crawford's invention, as modified by Katims, discloses all of the claimed limitations from above except for the means for attaching comprising a pair of clips.

However, Hook teaches the means for attaching comprising a pair of clips (pg. 1, col. 1, lines 71-76).

Given the teachings of Hook, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the apparatus for locating an electrically conductive probe disclosed by Crawford with the means for attaching comprising a pair of clips.

Doing so would provide the connection needed to create a complete circuit to allow the power source to generate a signal so that the probe could then be located.

Regarding claim 4, Crawford et al.'s invention fails to disclose the circuit, comprising a pair of wires connected to the signaling mechanism, one of the pair of clips connected to each wire, and the power source being in one of the wires.

However, Katims teaches an apparatus, wherein the circuit comprises a pair of wires connected to the signaling mechanism, one of the pair of clips connected to each wire, and the power source being in one of the wires.

Given the teachings of Katims, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the apparatus for locating an electrically conductive probe disclosed by Crawford, with the wires, clips connected to the wires, signaling mechanism, and power source in the wires.

The component parts of the signaling device, pair of clips, and power source are all previously mentioned in claims 1-3. The only difference is the combination of the parts by a pair of wires. Thus, it would have been obvious to one having ordinary skill in the art to combine the parts taught by Crawford et al., Katims and Hook, since the operation of the aforementioned circuitry could be used in combination with the pair of wires to achieve the predictable results of completing the circuit.

8. **Regarding claim 5,** Crawford et al.'s invention teaches on an apparatus for facilitating location of an electrically conductive probe extending through a body passage, using a tool, but fails to disclose the power source comprising a battery holder.

However, Katims and Hook teach the power source comprising a battery holder (Katims, col. 8, lines 3-4; Hook, Fig 2). Given the teachings of Katims and Hook, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the apparatus for locating an electrically conductive probe disclosed by Crawford with the power source being a battery holder.

Doing so would provide an alternative power source for providing power to the device.

9. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Crawford et al. (4,380,239)** in view of **Katims (US 5078714A).**

Regarding claim 6, examiner notes that this is a Jepson-type claim where all information before comprising is considered old (prior art). Crawford teaches all information regarding the probe and tool part of the claim, but fails to teach the circuit and its means for attaching the circuit to the probe and tool.

However, Katims teaches on a circuit which is normally open and which includes a signaling mechanism and power source for powering the signaling mechanism to generate a signal that can be perceived by a practitioner when the circuit is closed; and means for attaching the circuit to conductive portions of the probe, the circuit being closed for the probe to generate the signal (See Abstract, Fig. 2A).

It would have been obvious to a person of ordinary skill in the art to try combining the circuitry and signaling mechanism of Katims with the probe and tool taught by Crawford in an attempt to power the signaling mechanism, making it possible for a practitioner to then locate the probe, as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp.

9. Regarding claim 7, Crawford fails to disclose an apparatus, wherein the signaling mechanism generates at least one of an audible and a visual signal.

However, Katims teaches an apparatus, wherein the signaling mechanism generates at least one of an audible and a visual signal (col. 7, lines 8-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a signaling mechanism that generates an audible or visual signal as disclosed in Katims in the modification of an apparatus for facilitating location of an electrically conductive probe extending through a body passage, using a tool, to achieve the claimed invention.

The motivation for the combination would be to provide means for locating the probe through non-obtrusive means.

10. Claims 8,9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Crawford et al (4,380,239)** in view of **Katims (US5078714A),** as applied to the claims above, and further in view of **Hook (US1668847A).**

11. **Regarding claim 8,** Crawford's invention as modified by Katims, discloses all of the claimed limitations from above except for the means for attaching comprising a pair of clips.

However, Hook teaches the means for attaching comprising a pair of clips (pg. 1, col. 1, lines 71-76).

Given the teachings of Hook, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the apparatus for locating an electrically conductive probe disclosed by Crawford with the means for attaching comprising a pair of clips.

Doing so would provide the connection needed to create a complete circuit to allow the power source to generate a signal so that the probe could then be located.

Regarding claim 9, Crawford et al.'s invention fails to disclose the circuit, comprising a pair of wires connected to the signaling mechanism, one of the pair of clips connected to each wire, and the power source being in one of the wires.

However, Katims teaches an apparatus, wherein the circuit comprises a pair of wires connected to the signaling mechanism, one of the pair of clips connected to each wire, and the power source being in one of the wires (See Abstract, Fig. 2A).

Given the teachings of Katims, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the apparatus for locating an electrically conductive probe disclosed by Crawford, with the wires, clips connected to the wires, signaling mechanism, and power source in the wires.

The component parts of the signaling device, pair of clips, and power source are all previously mentioned in claims 6-8. The only difference is the combination of the parts by a pair of wires. Thus, it would have been obvious to one having ordinary skill in the art to combine the parts taught by Crawford et al., Katims and Hook, since the operation of the aforementioned circuitry could be used in combination with the pair of wires to achieve the predictable results of completing the circuit.

12. **Regarding claim 10**, Crawford et al.'s invention teaches on an apparatus for facilitating location of an electrically conductive probe extending through a body passage, using a tool, but fails to disclose the power source comprising a battery holder.

However, Katims and Hook teach the power source comprising a battery holder (Katims, col. 8, lines 3-4; Hook, Fig 2). Given the teachings of Katims and Hook, it

would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the apparatus for locating an electrically conductive probe disclosed by Crawford with the power source being a battery holder.

Doing so would provide an alternative means for providing power to the device.

13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Crawford et al (4,380,239)** in view of **Katims (US5078714A).**

14. **Regarding claim 11,** Crawford discloses a method for facilitating location of an electrically conductive probe extending through a body passage, using a tool (pg.4, claim 5), but fails to disclose the step of providing a circuit which is normally open and which includes a signaling mechanism and power source for powering the signaling mechanism to generate a signal that can be perceived by a practitioner when the circuit is closed; as well as the step of attaching the circuit to conductive portions of the probe and the tool, the circuit being closed when the tool touches the probe to generate the signal.

However, Katims teaches the steps of providing a circuit which is normally open and which includes a signaling mechanism and power source for powering the signaling mechanism to generate a signal that can be perceived by a practitioner when the circuit is closed; and the step of attaching the circuit to conductive portions of the probe, the circuit being closed when the tool touches the probe to generate the signal (See Abstract).

Given the teachings of Katims, it would be obvious to one of ordinary skill in the art at the time of the invention to modify Crawford's invention with the steps of providing

the circuit, signaling mechanism, and of attaching the circuit to conductive portions of the probe and the tool. Doing so would facilitate an improved way to guide a probe through a comprised area for treatment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Walsh et al. (US 6,547,765 B1), Ector, Jr. (4,658,816), Scanlon (US 5,853,005 A).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kendra L. Jones whose telephone number is (571) 270-3858. The examiner can normally be reached on M-Th, 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrell McKinnon can be reached on (571) 272-4797. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kendra Jones
December 14, 2007

/Terrell L Mckinnon/

Supervisory Patent Examiner, Art Unit 4148